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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,275	08/01/2003	Chris Graham	MSFT-2187/304791.2	5468
41505 7590 03/17/2010 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
OSMAN, RAMY M				
ART UNIT		PAPER NUMBER		
2457				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,275

Applicant(s)

GRAHAM ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2457

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-64 is/are rejected.
- 7) ☒ Claim(s) 17-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 11/20/09

DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on November 20, 2009, which is following a Notice of Allowance dated 8/21/2009. Claims 17-64 remain pending.

Information Disclosure Statement

2. MPEP Section 2004 "Aids to Compliance with Duty of Disclosure) recites:

It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. Molins PLC v. Textron Inc., 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995)." **MPEP 2004**

It is noted that the IDS's of 11/20/2009 is 6 pages long and represents 106 references spanning thousands of pages of highly technical disclosure, which meets the test of a "long list". The references cited in the IDS's of 11/20/2009 will not be considered until an underlining of the most relevant documents is provided, per M.P.E.P. 2004. (Please do not delineate the references using a highlighter since the documents will be scanned and the highlighted sections will not be visible.) Applicant's forthcoming assistance is gratefully anticipated.

Requirements:

A. Stipulate whether each and every individually cited reference listed in the IDS's submitted on 11/20/2009 is material to the patentability of the instant application; the applicant may either agree or disagree for each cited reference:

1. Identify, for each and every citation listed on the IDS(s) submitted 11/20/2009, for which applicant agrees is material to the patentability:

a. The differences between the claimed invention and those references cited therein,

b. How each reference is material to the patentability, based upon the technical and legal knowledge of the Applicant, of the claimed invention,

c. Provide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submissions dated 11/20/2009.

B. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) used in drafting the instant application, whether cited or not in the IDS submission(s) dated 11/20/2009.

C. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was used in the inventive process to accomplish the applicant's inventive results.

D. Provide the date of first use of the claimed invention, known to by any of the inventors or Applicant, at the time the application was filed notwithstanding the date of use.

E. Trademark(s) or Copyright(s) for the product(s) incorporating the instant claimed invention.

F. In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 11/20/2009 as well as each and every IDS submission thereafter, as delineated in requirement A.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

4. Independent claims 17 and 25 objected to because of the following informalities: Applicant is requested to change the preamble to recite: "A non-transitory computer-readable storage medium...". Their corresponding dependent claims are similarly objected to as depending upon an objected base claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. Claims 33-48 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant method claims are neither positively tied to a particular machine or hardware element that accomplishes the claimed method steps, nor do the claims perform transformation of underlying subject matter into a different state or thing. Since neither of these requirements are met, the method claims are not a patent eligible process under 35 USC 101 and are deemed as non-statutory subject matter.
6. Claims 49-64 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a "system". The scope of the limitation "system" encompasses software-only embodiments since the specification mentions embodiments utilizing

user-interfaces, reflector application, etc.. Software is not statutory because it is simply abstract ideas and is not directed to an actual physical device. For a claim like this to be statutory, it is required to be tied to a type of hardware device. These claims do meet this criterion and are therefore deemed non-statutory. **See MPEP Chapter 2106.01 Section I.**

Conclusion

7. Applicant may not introduce any new matter to the claims or to the specification. For any subsequent response that contains new/amended claims, Applicant is required to cite its corresponding support in the specification. (See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2457

March 11, 2010

